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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,789	11/07/2001	Jonas Lee	941-002	1847
38137	7590	04/10/2006	EXAMINER	
ABELMAN, FRAYNE & SCHWAB 666 THIRD AVENUE, 10TH FLOOR NEW YORK, NY 10017			PRIETO, BEATRIZ	
			ART UNIT	PAPER NUMBER
			2142	
DATE MAILED: 04/10/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,789

Applicant(s)

LEE ET AL.

Examiner

Prieto B.

Art Unit

2142

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 3/10/2006 has been entered.

Claim Rejection under 35 USC 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. At least claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In this case, claim (1) limitations reads, a server operatively connected to a user terminal operated by a user, the server including: "...so that the user terminal coupled to said server and to *a separate resource provider* receives other content from the resource provider and receives the selected advertising content...". This claim limitation as amended reads [AS BEST UNDERSTOOD], that the user terminal is separate from the resource content provider. This raises uncertainties with respect to what is argued, specifically, that *the resource provider is separate from and independent of the server, which provides other content to the user terminal*. It is respectfully noted that according to applicant's disclosure, the resource content provider (300a, 300b) is separate from the server (100) (see Fig. 1A).

Further limitation of claim 1 includes, "where the *user terminal provides* such advertising content simultaneously with the other content". This claim limitation raises uncertainties with respect to what entity is being provided advertising content. It is respectfully noted, that according to previous limitation the advertising content is selected by a module included in the server, namely, "decision maker module". The campaign content is delivered to the consumer, according to the abstract. Clarification is required. For the purposes of examination, the claim limitation reads that advertising content is *provided to* the user terminal.

Claim Rejections - 35 USC § 103

4. Quotation of 35 USC 103(a) which forms the basis for all obviousness rejections set forth in this Office action may be found in previous office action.

5. Claims 1, 6-7, 15, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas (US 6,128,663) in view of Eldering et al (US 6,820,277) (referred to as Eldering hereafter).

Regarding claims 1 and 20, Thomas teaches

a server operatively connected to a user terminal operated by a user, the server including: an advertising administration module, configured to maintain advertising content associated with at least one advertising campaign (col 1 lines 65-67, col 2, line 1), an advertising administration module, configured to maintain a plurality of advertising content associated with at least one advertising campaign (col 7, lines 48-55); said user terminal interface module configured to retrieve user information corresponding to said user terminal, for use by said advertising administration module (col 2, lines 45-50); said decision maker module configured to select one of said advertising content associated with at least one advertising campaign, based on said user information including consumer data specific to the user and obtained at least directly from said user terminal, so that the user terminal coupled to said server receives the selected advertising content corresponding to information retrieved by said server (col 2, lines 55-65). Thomas teaches a user terminal coupled to said server over the Internet (202) and thus to a separate resource provider (Fig. 2), and wherein the user terminal is provided said selected advertising content simultaneously with the other content, i.e. along with the other content (col 2, lines 51-63, and col 4, lines 53-65). Thomas does not explicitly teach of a user terminal interface module coupled to said advertising administration module nor a decision maker module coupled to said advertising administration module. In an analogous art, Eldering teaches on these aspects (col 5, lines 9-10, col 6, lines 5-10, fig 1). It would have been obvious to one of ordinary skill in the arts at the time of invention to incorporate the above teachings because the inventions are analogous art (providing targeted advertisements to consumers). One of ordinary skill in the arts at the time of invention would have been motivated by the reasons discussed by Thomas (col 1, lines 60-65).

Regarding claim 15, comprises limitations similar to claim 1, same rationale of rejection is applicable. Thomas teaches: a server operatively connected to a user terminal operated by a user (col 1 lines 65-67, col 2, line 1), an advertising administration module, configured to maintain a plurality of advertising

content associated with at least one advertising campaign (col 7, lines 48-55); said user terminal interface configured to retrieve user information corresponding to said user terminal, for use by said advertising administration module (col 2, lines 45-50); selecting one of said advertising content associated with at least one advertising campaign, based on said user information including consumer data specific to the user and obtained at least directly from said user terminal, wherein the consumer data specifically identifying the user and obtained at least directly from the user terminal is selected from the group of: the age of the consumer, the economic status of the consumer, and the language of preference of the consumer (col 11, lines 60-65, col 12, lines 10-15) so that the user terminal coupled to said server receives the selected advertising content corresponding to information retrieved by said server (col 2, lines 55-65); selecting the mode of appearance of said advertising content (col 2, lines 5-10, col 4, lines 5-10). However, Thomas does not explicitly teach a decision maker module coupled to said advertising administration module, nor a design user interface module configured to allow the user using the user terminal to specify a set of rules corresponding to an advertising campaign, said set of rules defining conditions for which specific advertising content is selected. In an analogous art, Eldering teaches an user terminal interface module coupled to said advertising administration module (col 5, lines 9-10) nor a decision maker module coupled to said advertising administration module (col 6, lines 5-10) nor a design user interface module configured to allow the user using the user terminal to specify a set of rules corresponding to an advertising campaign, said set of rules defining conditions for which specific advertising content is selected (col 5, lines 10-35). Refer to claim 1 for motivation.

Regarding claims 6-7, Eldering teaches of a memory unit that stores a set of rules corresponding to each of said advertising campaigns, said set of rules defining conditions for which specific advertising content is selected (col 5, lines 30-35, fig 1, item 102) and an information template flesh-out module coupled to said advertising maintenance module configured to retrieve information required by said rules (col 6, lines 1-20, fig 1).

6. Claims 2-5, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Eldering as applied to claim 1 above, and further in view of Parekh et. al. (US 6,757,740)

Regarding claims 2-5, and 17, Parekh teaching related to method for profiling Internet users (column 1, lines 20-25) teaches retrieving geographical location of said user terminal for use by said server (column 3, lines 2-4), wherein location include user terminal accessing services over the Internet, thereby location information consists of a metropolitan area, and wherein retrieving includes the specification of peripheral

devices such as hardware specifications (column 3, lines 45-55 and Fig. 14b). It would have been obvious to one of ordinary skill at the time the invention was made to include Parekh's teachings for utilizing user specific information for modifying the content provided to the users based on said specific user data and/or information. One of ordinary skill would have been motivated in combining the teachings of Parekh with Thomas because in doing so online user can be targeted with content, advertising, or routed traffic depending upon the geographic locations of their online users/visitors. Additionally, to discussed obtained profile information, the central database can store visitor's preferences as to what content should be delivered to an IP address, the available interface, and the network speed associated with that IP address, as suggested by Parekh.

7. Claims 8-9, 10-14, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Eldering, as applied to claim 1 above, and further in view of Liu (US 6,839,680).

Regarding claims 8-9, and 10-14, Thomas does not teach tracking the time said advertising content is displayed and the amount of time, tracking the occurrence of a click through. Liu teaches tracking the time the advertising content is displayed on the user terminal (column 4, lines 36-40) and the amount of time, tracking the occurrence of a click through (column 12, lines 13-16, 40-45 and column 9, lines 30-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Liu's teachings for utilizing user specific information such as tracking the time said advertising content is displayed and the amount of time, tracking the occurrence of a click through for modifying the content provided to the users based on said specific user data and/or information. One of ordinary skill would have been motivated in combining the teachings of Liu with Thomas because in doing it will overcomes the limitations noted thereby in the prior art, an complement Thomas system by including an adaptive profile model of user's interests over time, wherein user's time based model of interests and group memberships forms a detailed profile of the Internet activity that can be used to market information and products to the user, to customize web content dynamically, or for other marketing purposes, as suggested by Liu.

Regarding claims 18-19, wherein said user information includes hardware specification of said user terminal (Liu: col 16, lines 30-35), wherein user information includes anonymous cookie profile information (Liu: col 16, lines 30-35), gender (Thomas: col 11, lines 53-67) and purchasing patterns (Liu:

col 2, lines 62-65). Liu teaches of...configured to analyze response rate of each advertising (col 12, line 15, col 33, lines 50-65, col 34, lines 5-25).

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas in view of Eldering as applied to claim 15 above, and further in view of Welsh et al (US 6,757,691).

Regarding claim 16, neither Thomas nor Eldering explicitly teach where the weather conditions in a geographical location of said user terminal. In an analogous art, Welsh teaches of wherein said user information includes weather conditions in a geographical location of said user terminal (col 3, lines 40-45). It would have been obvious to one of ordinary skill in the arts at the time of invention to incorporate the above teachings because the inventions are analogous art (providing targeted advertisements to consumers). One of ordinary skill in the arts at the time of invention would have been motivated by the reasons discussed by Thomas (col 1, lines 60-65).

Response to Arguments

9. Regarding claims 1, 6-7, 15 and 20 rejected as being unpatentable over Thomas in view of Eldering, it is argued that the applied reference(s) do not teach claim limitation as amended. Specifically (p. 11 pf remarks), do not teach where the resource provider is separate from and independent of the server, which provides other content to the user terminal. Because according to applicant's interpretation of the applied reference(s), the Thomas patent is single system of one server which returns both advertising content, such as banner ads, and other content, such as webpage text to the user terminal for display to the user.

In response to the above-mentioned argument, applicant's interpretation of the applied references has been carefully reviewed. However, Thomas teaches where the advertising content (306 of 3A) may provided on a remotely located third-party server, (column 7, lines 49-57, i.e. separate from server 300/204 of Fig. 3A) and where the identifying server (308/206 of Fig. 3B is separate from server 300/204 as shown of Fig. 3A) and thereby, also separate from remotely located third-party advertising content server. Thus, Thomas teaches a user terminal coupled to said server and to a separate resource provider.

Eldering teaches where the content provider and the advertising content provider are separate from the system 100 as shown on Fig. 1., where the AMS 100 is implemented on server based technology, where in one embodiment the portions of the system which interface to the Internet are based

on Java and Java scripts (column 9, line 66 to column 10, line 9) and program streams (content) to which advertise content is inserted may be Internet web traffic or television programming (column 9, lines 10-12). Thus, Eldering teaches where the user terminal is coupled to a server and to a separate resource provider and/or where the user terminal is coupled to a server, where the resource provider is separate from the server.

10. Regarding claims 2-14 and 16-19 dependent from amended independent claims 1 and 15, respectively, and so includes the recitation of amended claims 1 and 15, respectively. It is argued (p. 14 of remarks) that for the same reasons set forth above, these claims are according to applicant distinguishable over the prior art.

In response to the assertion, for the same reasons provided with respect to argument(s) associated with independent claims, these dependent claims are not distinguishable over the applied prior art of record.

11. Applicant's arguments filed with the above-mentioned amendment have been fully considered but not found persuasive.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Prieto, B. whose telephone number is (571) 272-3902. The Examiner can normally be reached on Monday-Friday from 6:00 to 3:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, Andrew T. Caldwell can be reached at (571) 272-3868. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3800/4700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system, status information for published application may be obtained from either Private or Public PAIR, for unpublished application Private PAIR only (see <http://pair-direct.uspto.gov> or the Electronic Business Center at 866-217-9197 (toll-free).

Any response to this action should be mailed to:
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Primary Examiner
TC 2100
April 6, 2006


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PRIMARY EXAMINER